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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/814,300	04/01/2004	Gregory Plos	05725.1310-00000	8608
22852	7590	08/28/2006	EXAMINER	
FINNEGAN, HENDERSON, FARABOW, GARRETT & DUNNER LLP 901 NEW YORK AVENUE, NW WASHINGTON, DC 20001-4413			ELHILO, EISA B	
			ART UNIT	PAPER NUMBER
			1751	

DATE MAILED: 08/28/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/814,300

Applicant(s)

PLOS ET AL.

Examiner

Eisa B. Elhilo

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 22 June 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-59 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-16, 19-44, 46 and 49-59 is/are rejected.
- 7) ☒ Claim(s) 17, 18, 45, 47 and 48 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>6/22/2006</u> . | 6) <input type="checkbox"/> Other: _____  |

### DETAILED ACTION

1 This action is responsive to the amendment filed on June 22, 2006.

2 The rejection of claims 1-14, 16, 19-21,26-43, 46 and 50-59 under 35 U.S.C. 103(a) as being unpatentable over Matsunaga et al. (US 2001/0054206 A1) in view of Pratt (US (US 2003/0019052), is maintained for the reasons set forth in the previous office action mailed on March 23, 2006.

3 The rejection of claims 15 and 44 under 35 U.S.C. 103(a) as being unpatentable over Matsunaga et al. (US 2001/0054206 A1) in view of Pratt (US (US 2003/0019052) and further in view of Miyabe et al. (EP 1142559 A2), is maintained for the reasons set forth in the previous office action mailed on March 23, 2006.

4 The rejection of claims 22-24 under 35 U.S.C. 103(a) as being unpatentable over Matsunaga et al. (US 2001/0054206 A1) in view of Pratt (US (US 2003/0019052) and further in view of Vandebossche et al. (US 6,391,062 B1), is maintained for the reasons set forth in the previous office action mailed on March 23, 2006.

5 The rejection of claim 25 under 35 U.S.C. 103(a) as being unpatentable over Matsunaga et al. (US 2001/0054206 A1) in view of Pratt (US (US 2003/0019052) and further in view of Giuseppe et al. (US 5,744,127), is maintained for the reasons set forth in the previous office action mailed on March 23, 2006.

6 The rejection of claim 49 under 35 U.S.C. 103(a) as being unpatentable over Matsunaga et al. (US 2001/0054206 A1) in view of Pratt (US (US 2003/0019052) and further in view of Rondeau (US 6,436,153 B2), is maintained for the reasons set forth in the previous office action mailed on March 23, 2006.

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7        Claims 17-18, 45 and 47-48 objected to for the reasons set forth in the previous office action mailed on March 23, 2006.

***Response to Applicant's Arguments***

8        Applicant's arguments filed 6/22/2006 have been fully considered but they are not persuasive.

With respect to the rejection of claims 1-14, 16, 19-21, 26-43, 46 and 50-59 under 35 U.S.C. 103(a) as being unpatentable over Matsunaga et al. (US 2001/0054206 A1) in view of Pratt (US (US 2003/0019052), Applicant argues that the examiner has failed to point to any evidence of a suggestion or motivation to modify Matsunaga's composition to arrive at the claimed invention.

The examiner respectfully disagrees with the above arguments because the primary reference of Matsunaga et al. (US' 206 A1) suggests the use of a polyol as one of the five dyeing ingredients that preferred to be added to the dyeing composition for dyeing hair uniformly and to improve the cosmetic effects as well (see page 3, paragraph, 0024). Pratt (US' 052 A1) as a secondary reference in analogous art of hair dyeing formulation teaches a composition comprising polyol such as 1,4-butanediol that represents the claimed formula (I) (see page 4, paragraph, 0053). Therefore, there is a clear suggestion and sufficient motivation to one having ordinary skill in the art to be motivated to incorporate the claimed polyols are taught by Pratt (US' 052 A1) in the dyeing composition of Matsunaga et al. (US' 206 A1) to arrive at the claimed invention with a reasonable expectation of success for improving the dyeing properties of the composition for dyeing hair uniformly. Therefore, the prima facie case of obviousness has been established.

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With respect to the Applicant's argument that there is no suggestion or motivation to choose a specific diol such as 1,4-butanediol, the examiner would like to point out that Pratt (US' 052 A1) discloses 1,4-butanediol among a limited number of the preferred substances (polyol) (see page 4, paragraph, 0053). Therefore, the list of polyols disclosed by Pratt is very short and limited to allow a person of the ordinary skill in the art to choose from.

In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

With respect to the rejections of the claims under Matsunaga in view of Pratt and further in view of Miyable, Vandebossche, Giuseppe or Rondeau, Applicant argues that Miyable, Vandebossche, Giuseppe and Rondeau do nothing to cure the deficiencies of the 103(a) rejection over Matsunaga in view of Pratt.

The examiner respectfully disagrees with the above arguments for the same reasons given above.

9 **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO

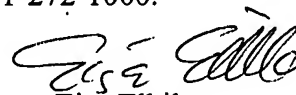
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MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Eisa B. Elhilo whose telephone number is (571) 272-1315. The examiner can normally be reached on M - F (8:00 -4:30).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Douglas McGinty can be reached on (571) 272-1029. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

  
Eisa Elhilo  
Primary Examiner  
Art Unit 1751

August 21, 2006